

### **Remarks**

Claims 1 to 18 are currently pending. Claims 1-4 and 6-17 have been amended. Entry of these amendments and reconsideration of the application are respectfully requested.

### **§ 112 Rejections**

Claims 1-18 were rejected under 35 USC § 112, second paragraph. This rejection has, in large part been avoided by the above amendments. As discussed in the interview, the Examiner's suggestion has been followed in all claims except claim 12. The terminology "fibers" has been replaced with "discontinuous layers" and "phases" as suggested by the Examiner. In claim 12, the word "further" was not added because there is adequate basis for claiming discontinuous phases comprising a dye or colorant. Claim 12 was part of the original disclosure, and, as such, constitutes part of the original description of the claimed invention. In addition, there is basis for such a claim in specification page 15, lines 1-3 and Example 13. As amended, claims 1-18 comply with 35 USC § 112, second paragraph.

### **§ 103 Rejections**

Claims 1-18 have been rejected under 35 USC § 103(a) as obvious over either the English translation of DE '452 or WO '857 in view of either Wyeth et al. U.S. Patent 3,982,887 or Schrenk et al. U.S. Patent 3,759,647. This rejection is traversed. In the discussion below, the rejection will be treated as applying to claim group I (claims 1-8, 13 and 14).

Attached to this amendment is a table comparing certain limitations in the claims of this application with the disclosures of the references cited against them. The undersigned attorney has studied the references, and, if a listed claim limitation was found in a reference, it was noted by its location in the reference in the table. A blank space in the table corresponding to a claim limitation indicates that no disclosure of that limitation was found in the reference. The abbreviated descriptions of the claim limitations in the table are for purposes of convenient presentation in table form and do not change the actual claim language or scope.

As shown by the table, there are substantial differences between the claims, as amended, and the references. As to claim 1, WO '857 is lacking disclosure of a pressure sensitive adhesive

(psa) layer. At Office Action page 3, the Examiner has said that, “both DE –452 and WO –857 disclose, in certain embodiments, polymeric co-extruded multilayer webs ... made from a variety of ... well known polymers that can include adhesives.” At Office Action page 4, the Examiner has stated, “pressure sensitive adhesives can be utilized as both tie layers or ‘glue’ ....”

Although WO ‘857 discloses adhesive or glue at page 27, ll. 16-29, p. 29, ll. 18-21 and p. 30, ll. 25-33, it does not disclose psa. Pressure sensitive adhesives are a class of adhesives recognized in the art and defined at specification page 5, first paragraph. The Examiner’s assertion that pressure sensitive adhesives are known to function as tie layers in multilayer extruded films is specifically traversed, and he is requested to support it by a prior art reference or withdraw it. Contrary to the Examiner’s assertion, tie layers are defined in U.S. Patent 6,045,895 (col. 1, ll. 36-46) as intermediate layers in a multilayered construction which generally have an affinity for both of the principal layers and typically consist of materials that will not significantly reduce the overall tensile properties of the multilayer construction. Tie layers are said to typically be hot melt adhesives as opposed to psa’s.

DE ‘452 teaches a thermoplastic film in which thermoplastic elastomer (TPE) is coextruded with a thermoplastic resin and/or another TPE in parallel strips (“like two intersecting combs” see p. 3, third full paragraph). That film may be coated with a thin cover layer of plastic (p. 7, 6<sup>th</sup> full paragraph). Although DE ‘452 discloses a cover layer on his thermoplastic film, the resulting film would not have at least 2 discontinuous layers plus at least three continuous layers, as required by the rejected claims. DE ‘452 distinguishes itself from multilayer films. In the penultimate paragraph on page 2 of the reference, it draws a contrast between its composite structure (having different synthetic resins side-by-side) with film layers on top of each other obtained through co-extrusion techniques. At page 5, second full paragraph, DE ‘452 further distinguishes its films from co-extruded multilayer films, stating that the co-extruded films are isotropic. The goal of DE ‘452 is a film that is plastic in the length direction but elastic cross-web (p. 2, 5<sup>th</sup> paragraph). Besides not being a co-extruded multilayer web, DE ‘452 lacks any teaching regarding at least one continuous, co-extruded psa layer as required in claim 1.

At Office Action page 4, the Examiner has said that Wyeth and Schrenk were, “relied upon only to show that thermoplastic materials can be made of a variety of layers and can be formed with a variety of fluid passageways and ‘a pattern of interconnected or disconnected

projections, grooves ....' [quoting Wyeth, col. 2] ... and ... [quoting Schrenk] 'a wide variety of structures may be produced. Particularly beneficial and advantageous are ... films ... prepared by employing diverse thermoplastic resinous materials in adjacent layers ....'”

With all due respect:

- The fact that Wyeth discloses a pattern of interconnected or disconnected projections, grooves, embossed pits, valleys or corrugations in one or two sheets does not overcome the differences between the two primary references and the claims. Wyeth teaches a laminated article comprising two sheets in interfacial contact one of which has projections, but has no teaching of at least two layers of discontinuous phases embedded between continuous layers.
- The passage from Schrenk quoted by the Examiner is in a paragraph discussing the iridescent films that can be made by employing his inventive apparatus. Those iridescent films are made by employing diverse thermoplastic resinous materials in adjacent layers; but, Schrenk does not supply the limitations missing in the primary references (see comparison table).
- Wyeth and Schrenk do not provide any of the unique material combinations found in: claims 4, 5, and 7 (at least two discontinuous layers embedded between at least three layers of acrylic psa; and claim 6 (continuous layers of foamed polymer).

There was no guarantee that the claimed combinations of layers in a multilayer web would work, and neither Wyeth nor Schrenk (despite the variety of materials they contain) lead one to use the unique material combinations of the present claims, e.g.: psa continuous layers combined with discontinuous layers of thermoplastics or elastomeric materials, or foamed psa continuous layers.

In order to arrive at the claims as amended, one must modify the references by adding to them the features shown as missing in the attached comparison table. In order to have claim1, one would have to make a continuous psa layer in the multilayer webs of WO '857, despite the fact that no psa is mentioned in WO '857. One would have to modify DE '452 by: i) changing its single layer of side-by-side strips of TPE and thermoplastic or other resin to at least two layers that are discontinuous cross-web and continuous down-web; ii) adding enough continuous layers (beyond the cover layer disclosed in DE '452) to have at least three continuous layers down-web and cross-web; iii) embedding each discontinuous layer between continuous layers; and iv)

arranging the discontinuous layers so that they are separated from each other by continuous layer material; all of this without any teaching in the references to make such modifications.

In order to arrive at claim 4, 5 or 7, one would have to modify WO '857 and DE '452 by introducing at least three continuous acrylic psa layers, with no teaching on such layers in the references cited.

In order to have claim 6, one must use foamed psa as a continuous layer material in a co-extruded, multilayer web despite the lack of any foamed psa in any of the references.

In order to have claim 8 one must use as continuous layer material blends of polyolefins and elastomeric block copolymers, natural or synthetic rubbers or blends of isotactic polypropylene and elastomeric polypropylene, despite the absence of such blends in any of the references.

There is no reason that arises from the cited art itself for making these modifications and overcoming the differences between the claims and the patents cited.

The Examiner has said at Office Action page 3 that, "With respect to the broad genres of embodiments that are claimed ... these are believed merely to recite a wide variety of generic compositions and related species as well as layers and other conventional structures in the art whose selection is but an obvious design choice ...." This assertion by the Examiner is specifically traversed. The materials recited in the claims mentioned above are not mere obvious design choices. As the comparison table shows, they are novel over the references cited. If references showing that these materials would be expected to work in this application (multilayer coextruded films containing phases that are discontinuous cross-web and continuous down-web) are not cited, the rejections based on this assertion should be withdrawn.

The patentability of claims after claim 1 is urged separately from claim 1 itself, since these claims cover inventive concepts that add to the concept of claim 1 and are even more unobvious over the cited art. The concept of reinforced multilayer psa web is covered in at least claims 4, 5 and 7. It is described in the specification at page 12, line 30-page 14, line 8 and Examples 1-7. The concept of reinforced foam psa web is covered by independent claim 6, and is described in the specification at page 13, lines 15-28 and Examples 8-10.

At Office Action page 5, the Examiner has referred to the "prima facie case of record". With all due respect, a *prima facie* case has not been established on the record. Under MPEP 2141,a

*prima facie* case requires that, after the scope and content of the prior art is determined: the differences between the prior art and the claims at issue be ascertained; and the level of ordinary skill in the pertinent art resolved. In addition, secondary considerations of non-obviousness are to be evaluated. MPEP 2143 requires that the prior art must teach or suggest all the claim limitations, and there must be: some suggestion or motivation in the references or in the knowledge generally available to modify the reference or combine reference teachings, and a reasonable expectation of success. The art cited by the Examiner does not teach or suggest all the claim limitations. No explanation (other than the Examiner's unsubstantiated assertions) has been supplied for why it would be obviousness to a person of ordinary skill to make all of the modifications recited above necessary to overcome the differences between the present claims and the prior art. Nor has any explanation been provided for why there would have been a reasonable expectation of success if one had fortuitously made such modifications. Hindsight with the benefit of the knowledge of the present claims is required to make these modifications, and hindsight is not a proper basis for a rejection under 35 U.S.C. 103 (MPEP2141.01).

At the bottom of Office Action p. 4, the Examiner has referred to "applicant's contention that he has discovered unexpected results". The recitations of certain benefits of the presently claimed invention at pages 10-11 of the last response were not an assertion of unexpected results. They were facts presented to support non-obviousness. They are features of the invention found in the specification, e.g., improved strength in the embodiments of claims 4-7. The cited prior art patents give no hint that these advantageous properties of the inventive films would be obtained by modifying the teachings of the prior art, and this is another indication contrary to obviousness.

As indicated above, the Examiner's restriction requirement, if issued, would be traversed. The inventive concepts covered by claim groups I-II should all be examined together since they all relate to multi-layer extruded webs having discontinuous layers embedded between continuous layers. Claims 1-18 can and should be searched simultaneously.

In view of the above discussion, it is respectfully submitted that all the claims 1-18, as amended, are in condition for allowance. Withdrawal of the rejections under 35 U.S.C. 112 and 103 are requested and a notification of allowability is respectfully solicited. If any issues or questions remain the resolution of which the Examiner feels would be advanced by a conference

with Applicants' attorney, he is invited to contact such attorney at the telephone number noted below.

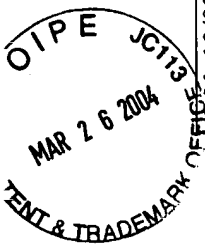
Respectfully submitted,

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Date

By: Douglas B. Little  
Douglas B. Little, Reg. No.: 28,439  
Telephone No.: (651) 733-1501

Office of Intellectual Property Counsel  
3M Innovative Properties Company  
Facsimile No.: 651-736-3833

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| S.N. 10/028,638  | WO 92/12857   | Schrenk | DE 19806452 A1 | US 3,759,647 Schrenk | US 3,982,877 Wyeth |
|--|---|---------|----------------|----------------------|--------------------|
| Claim 1, $\geq 2$ layers of fibers each layer comprising plurality of distinct phases that are continuous down-web | Abstract, Fig. 3, p. 6, ll. 26-31, p. 13, ll. 20-30, p. 14, ll. 21-24, p. 32, ll. 34-35 |         |                |                      |                    |
| $\geq 3$ layers continuous down-web & cross-web  | Figs. 3 & 4   |         |                |                      |                    |
| fiber layers embedded between continuous layers and  | Figs. 3 & 4, p. 7, p. 10, ll. 11-22   |         |                |                      |                    |
| are separated from each other by continuous layer material   | Fig. 3, p. 6, ll. 26-31, p. 10, ll. 11-15, p. 13, ll. 20-33, p. 14, ll. 21-32           |         |                |                      |                    |
| $\geq 1$ continuous layer is pressure sensitive adhesive   |   |         |                |                      |                    |
| Claim 4 Continuous layers are acrylic pressure sensitive adhesive and  |   |         |                |                      |                    |
| fibers comprise non-pressure sensitive adhesive, thermoplastic polyolefin, etc.                                    | p. 25, ll 8-9, 16   |         |                |                      |                    |
| Claim 6 continuous layers are foamed pressure sensitive adhesive   |   |         |                |                      |                    |
| Claim 8 continuous layers = Markush group blends of polyolefins and elastomers and                                 |   |         |                |                      |                    |
| discontinuous layers comprise Markush group cyclic polyolefins, etc.   |   |         |                |                      |                    |
| Claim 14 2 continuous layers between each layer of fibers  |   |         |                |                      |                    |